

REMARKS

Claims 6-10 are pending in this application. By this Amendment, claims 6-9 are amended and claims 1-5 are canceled. Support for the amendments to the claims may be found, for example, in the original claims and throughout the specification. No new matter is added.

In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

I. Rejections Under 35 U.S.C. §103(a)

A. Claims 1-4

The Office Action rejects claims 1-3 under 35 U.S.C. §103(a) over JP 2000-218165 (hereinafter "Takeshi") in view of WO93/10886 (hereinafter "Farrauto"), and rejects claim 4 under 35 U.S.C. §103(a) over Takeshi in view of U.S. Patent Application Publication No. 2003/0021948 to Ichikawa et al. (hereinafter "Ichikawa"). By this Amendment, claims 1-4 are canceled, rendering their rejection moot. Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

B. Claims 5 and 8-10

The Office Action rejects claims 5 and 8-10 under 35 U.S.C. §103(a) over U.S. Patent Application Publication No. 2003/0021949 to Tomita et al. (hereinafter "Tomita") in view of Farrauto. By this Amendment, claim 5 is canceled, rendering its rejection moot. As to the remaining claims, Applicants respectfully traverse the rejection.

By this Amendment, claim 6 is recast in independent form and claim 8 is amended to depend from non-rejected claim 6. Additionally, by this Amendment, claim 9 is amended to recite "wherein the heat treatment is conducted in an atmosphere containing oxygen and steam." Page 5 of the Office Action acknowledges that Tomita and Farrauto are silent in regard to creating an oxidizing atmosphere using steam.

For at least the foregoing reasons, Applicant respectfully submits that the rejection relying on Tomita and Farrauto is overcome. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

C. Claims 6 and 7

The Office Action rejects claims 6 and 7 under 35 U.S.C. §103(a) over Tomita in view of Farrauto in further view of U.S. Patent No. 5,998,328 to Dawes et al. (hereinafter "Dawes"). Applicants respectfully traverse the rejection.

The rejection is improper. The combination of Dawes with Tomita and Farrauto would not have rendered obvious the claimed invention, at least because the Office Action has failed to establish a proper *prima facie* case of obviousness.

Claim 6 and claim 9 (claim 9 is included herewith because claim 9 has been amended to include the subject matter of claim 6) require "a heat treatment, in an oxygen-containing atmosphere...wherein the heat treatment is conducted in an atmosphere containing oxygen and steam." This limitation is not disclosed in the applied references.

Dawes relates to an activated carbon catalyst that is coated onto a support. Dawes uses steam to activate the carbon, which supposedly enhances the volume and diameter of the micropores formed during carbonization.

There is no indication in Dawes that the presence of steam will promote oxide film formation according to the methods of claims 6 and 9, without carbon present. Thus, the Office Action's rejection of claim 6 (and claim 9) over the combination of Dawes with Tomita and Farrauto is improper because there is no reasonable expectation of success that the alleged combination will lead to the method of claim 6 (and claim 9).

As none of the applied references discuss specific materials behaving the same in the presence of steam without having a continuous coating of carbon present, and the Office Action has provided no factual support for its allegations, the rejections are improper because

the Office Action fails to provide a clear articulation of the rejection. MPEP § 2143 states that “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit” (emphasis added). The Office Action has not made such a clear articulation, and must do so in order to continue to support the claim rejections.¹

At most, it appears that the Office Action may be taking Official Notice that these materials will behave identically, or basing the rejection on alleged inherent properties. However, the application of Official Notice or inherency is not established and, thus, is improper in this case.

For at least the foregoing reasons, Applicants respectfully submit that Dawes does not remedy the deficiencies of Tomita and Farrauto as detailed above. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

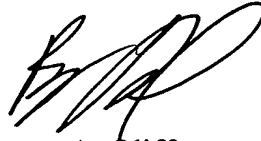
II. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

¹ To the extent that any such clear articulation or adequate reasoning for the obviousness rejections is included in a subsequent Office Action, such subsequent Office Action should be made non-Final.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Benjamin S. Prebyl
Registration No. 60,256

JAO:BSP/wma

Attachment:
Petition for Extension of Time

Date: August 29, 2008

OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

| |
|---|
| <p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p> |
|---|